No. 86-1917

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IN THE

Supreme Court of the United States

October Term, 1986

BARNES-HIND/HYDROCURVE, INC. and
BARNES-HIND INTERNATIONAL, INC.,
Petitioner,

vs.

BAUSCH & LOMB INCORPORATED,
Respondent.

ON APPEAL FROM THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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vs.

BAUSCH & LOMB INCORPORATED,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

A petition for writ of certiorari has been brought by Barnes-Hind/Hydrocurve, Inc. and Barnes-Hind International, Inc. (hereinafter "Barnes-Hind") to review a judgment of the Court of Appeals for the Federal Circuit. The Federal Circuit's judgment vacated and remanded a judgment of the District Court holding U.S. Patent No. 4,194,814 owned by Respondent Bausch & Lomb Incorporated (hereinafter "Bausch & Lomb") invalid and not infringed. The stated basis for the petition is that the Federal Circuit acted as a *de novo* fact finder in violation of Rule 52(a), Fed.R.Civ.P. (Pet. 14).[1] Barnes-Hind also makes reference to a petition filed on April 23, 1987 by Dennison Manufacturing Company, *Dennison Manufacturing Co. v. Panduit Corp.*, No. 86-1700, which Barnes-Hind claims presents

[1] References to "Pet.___" are references to pages in Barnes-Hind's Petition for Writ of Certiorari.

related questions concerning the applicability of Rule 52(a) to the alleged independent fact finding of the Federal Circuit in patent cases (Pet. II).

Barnes-Hind's reliance on Rule 52(a) and the *Dennison* petition is misplaced. The Federal Circuit's opinion in our case is explicit that the District Court judgment was vacated because of several legal errors to which the clearly erroneous provisions of Rule 52(a) do not apply. The Federal Circuit was fully cognizant of its appellate role and was careful not to make factual findings of its own, instead, remanding to the District Court to make those findings following correct principles of law:

> "In sum, the district court improperly determined the '814 patent was obvious: it failed to make the *Graham* inquiries, it improperly focused on what was obvious to the inventor, it engaged in hindsight analysis, and it considered evidence that was not prior art. This court, as an appellate court, may not make the required *Graham* factual findings, and must therefore remand that determination to the district court. The district court should not ignore the four-part analysis the authorities require." (Pet. 12a).

Against this background, there is no reason to grant Barnes-Hind's petition. The District Court's legal errors were so numerous and substantial that remand for new findings was required and Rule 52(a) simply is not a consideration. Since the remand was based on legal errors, the *Dennison* case also is wholly inapposite.

The petition also should be denied because no unusual question of law or fact exists, there is no issue of public importance involved, there has been no departure from the accepted and usual course of judicial proceedings, and the entire matter has been carefully and thoroughly reasoned by the Federal Circuit. In sum, no special or important reason exists for the intervention of this Court.

STATEMENT OF THE CASE

Bausch & Lomb provides the following Statement of the Case to correct several inaccuracies and omissions in Barnes-Hind's Statement of the Case (Pet. 3).

Further Background

1. The Subject Matter of The Lawsuit

The subject matter of this lawsuit is a patented soft contact lens formed of a transparent cross-linked polymer which has depressions created in its surface by a beam of laser radiation with a smooth surface of unsublimated polymer surrounding the depressions (Pet. 46a). The contact lenses with which the patented invention has found its principal application are toric lenses used for correction of astigmatism in the eye. Markings on the lens surface greatly facilitate this fitting process (F-17, Pet. 21a).[2]

Prior lens marking techniques required the use of foreign substances, such as ink, or mechanical marking tools, such as a sharp scribing or abrading tools (e.g., a dental burr) (F-18, F-20, Pet. 22a). There were several problems and disadvantages associated with these prior techniques (F-19, F-21, Pet. 22a). The contact lens of the patent in suit solved these problems and overcame these disadvantages.

2. The Application for the Patent in Suit

Before filing the application for the patent in suit, Milton Roy Company[3] sent the application to Donald Hager, one of the inventors, for execution (F-68, Pet.

[2] References to "F-___" are references to the Findings of Fact and Conclusions of Law of the District Court in the Appendix to Barnes-Hind petition.

[3] Respondent Bausch & Lomb purchased the patent in suit from Milton Roy Company after the patent application was filed (F-9, Pet. 20a).

29a). At that time, Mr. Hager no longer was employed by Milton Roy as he had gone to work for a competitor in the contact lens business, Sauflon International, Inc. (F-66, Pet. 28a). While at Sauflon, Mr. Hager installed a corresponding lens marking system using a laser to mark the lens (A24-A25). Mr. Hager refused to sign the patent application and sent back a letter to Milton Roy stating that he did not feel that he had invented anything in connection with laser marking of contact lenses or that the results he obtained were unexpected (F-69, Pet. 29a). Milton Roy later filed the patent application, executed by the other inventors, David Fischer and James McCandless, accompanied by a declaration which described Mr. Hager's refusal to sign and attaching his letter to that effect (A14-A19); (F-70, Pet. 29a).

On August 12, 1982, after the patent in suit had issued, Bausch & Lomb, who now owned the patent, wrote to Mr. Hager and requested him to join as an inventor (F-71, Pet. 29a). In response, Mr. Hager executed the necessary declaration and power of attorney and assignment papers (F-74, Pet. 29a). Mr. Hager's declaration stated that he had reviewed and understood the contents of the patent application, and that he believed himself to be one of the original and first inventors of the subject matter which was claimed and for which the patent was sought (A20-A21). Mr. Hager executed his declaration on September 13, 1982, more than two years after the issuance of the patent in suit and after Mr. Hager had left Sauflon International, Inc. In May of 1984 during his deposition before trial, Mr. Hager flip-flopped again, stating he did not make any invention or that laser marking was an invention (F-75, Pet. 30a).

The District Court's findings[4] reveal that in declaring the patent in suit invalid, heavy reliance was placed on Mr. Hager's opinion that he had not invented anything. Finding 90, one of the few findings independently authored by the District Court, stated:

> "(90) The fact that the claimed subject matter of the patent in suit was obvious to Mr. Hager is most indicative of the obviousness of the invention." (F-90, Pet. 32a).

The District Court's Flawed Analysis

This Court's decision in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966) requires that a trial court, in determining obviousness under 35 U.S.C. 103, make factual determinations regarding (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations such as commercial success, etc. The District Court failed to adhere to this analysis and committed legal errors virtually every step of the way in reaching its findings.

1. Scope and Content of the Prior Art

Barnes-Hind relied at trial on prior patents to Brucker and Caddell, Nos. 3,833,786 and 3,549,733, respectively, to carry its burden of clear and convincing evidence that the invention of the patent in suit would have been

[4] Of the District Court's Findings of Fact and Conclusions of Law, findings 1-21 were not in dispute, findings 22-86 were adopted substantially verbatim from Barnes-Hind's proposed findings authored by Barnes-Hind before the trial ended (A1-A13), and only findings 87-91 were prepared independently by the District Court (Pet. 32a).

obvious (Pet. 7). Both the Brucker and Caddell patents had already been considered by the patent examiner at the U.S. Patent and Trademark Office during the examination of the application for the patent in suit (F-30, Pet. 23a). The examiner issued the patent in suit over the Brucker and Caddell patents and with full knowledge of Mr. Hager's opinion.

The District Court also relied on the experiments of Dr. Brucker in laser marking contact lenses to support its finding of obviousness (F-91, Pet. 33a). At trial, however, when Dr. Brucker was asked when his company began to experiment with laser marking of soft contact lenses, he replied "I believe it was in '79. '79, '80, somewhere in that area." (A49). The application for the patent in suit was filed in 1977 (Pet. 46a), long before Dr. Brucker's experiments, and the District Court's reliance on these experiments as prior art was error.

2. The Differences Between the Claimed Invention And the Prior Art

In determining the differences between the invention claimed in the patent in suit and the prior art Brucker and Caddell patents, the District Court concluded:

> "(48) Thus, the concept of forming ridgeless depressions having smooth rounded edges in plastic using a laser beam to vaporize the material is explicitly disclosed in the Caddell patent. *That is exactly the same process in the patent-in-suit and practiced by plaintiff.*" (F-48, Pet. 26a) (emphasis in original).

The District Court selected a single line out of the Caddell patent to support the above finding (Pet. 10a), authored by Barnes-Hind (A7), while disregarding the immediately following sentences in Caddell which said this would be "virtually impossible" (Pet. 61a). This too was error.

3. The Level of Skill in the Art

Barnes-Hind's petition incorrectly states that the level of skill in the art had not been disputed by the parties (Pet. 8). To the contrary, Bausch & Lomb and Barnes-Hind completely disagreed on the level of skill. Bausch & Lomb adopted the patent examiner's description of the level of skill.[5] It further relied on the level of experience of its expert on optometry, Dr. Mandell, in the 1976 time period when the invention was made. Dr. Mandell, described his knowledge of other lens designers as well as his own work in designing contact lenses. He testified that most lens designers were optometrists, many of them had some engineering background or some background in machining, and they were generally self-taught or learned from other manufacturers. He did not know of even one designer of a contact lens in or about 1976 who came from the field of laser technology (A27-A30).

In contrast, Barnes-Hind relied on the testimony of Richard Miller, who described himself as a "laser engineer" (A39). Mr. Miller's highest level of education was a high school diploma (A44). His work experience up to 1977 constituted a variety of positions installing and operating laser equipment for industrial scribing and marking applications (A39-A41).

On the level of skill issue, Mr. Miller testified that most "laser engineers" he met at that time had less experience than he did (A44). In 1976 there were not a lot of people around the country in laser applications work, and he did not know even one of them who was involved in designing contact lenses (A45). He himself did not reach a degree of expertise that

[5] The patent examiner described the level of skill in the art as that of "the ordinary skilled contact lens worker. . . ." (A22).

he felt comfortable with the effects of lasers on polymers until 1978 (A45). It was not until 1979 that he first became aware of the application of a laser beam to a contact lens at all (A45).

In Barnes-Hind's Statement of the Case concerning level of skill in the art (Pet. 8), Barnes-Hind asserts "[t]he District Court had stated that the relevant area of technology included physiological optics, marking and the prior art." This assertion by Barnes-Hind is incorrect. The quoted statement of the District Court (Pet. 8) concerning "the relevant area of technology" is the trial judge's response to Barnes-Hind's objection to Bausch & Lomb's attempt to qualify Dr. Mandell as an expert witness on contact lenses, specifically in the areas of marking lenses and the prior art. The District Court's quoted statement merely identifies two areas in which further foundation was required to qualify Dr. Mandell: (1) in the area of marking; and (2) in the area of prior art. It was not a statement by the District Court or a finding concerning the level of skill in the art (A26-A27).

4. The District Court's Conclusion of Obviousness

Barnes-Hind's Statement of the Case concerning "The Trial Proceedings" (Pet. 8) selects isolated quotations from the trial record to support its view that the District Court's ultimate conclusion of obviousness was proper and based on the trial testimony of Bausch & Lomb's own witnesses.[6] Nothing could be further from the truth. Barnes-Hind's selective quotations present a misleading picture of the witnesses' true testimony. The selective quoting is most apparent regarding Dr. Mandell, who

[6] It is noted that the District Court could not have referred to the trial transcript at the time the Findings of Fact and Conclusions of Law (Pet. 19a) were entered because the transcript had not yet been prepared.

never testified that the invention would have been obvious, and Mr. Miller, whose laser marking of plastics in the 1976-1977 time period (when the invention was made) invariably produced a ridge. Rather than repeat the other pertinent portions of Dr. Mandell's testimony or the testimony of other witnesses to place the testimony in proper context, Bausch & Lomb has reprinted these portions in the accompanying appendix and invites this Court to review them as it should decide (A30-A49).

The Federal Circuit's Opinion Citing Legal Errors by the District Court

In vacating and remanding the District Court's judgment, the Federal Circuit cited several legal errors. Specifically, the Federal Circuit found at least seven legal errors by the District Court in determining that the patent in suit was invalid.[7] These legal errors are discussed below.

1. Reliance on Mr. Hager's Opinion That The Invention Was Obvious

As "most indicative of the obviousness of the invention" (F-90, Pet. 32a), the District Court relied on the opinion of Mr. Hager and his temporary refusal to execute the application for the patent in suit. The Federal Circuit found this to be a legal error and explained the state of the law in this area (Pet. 9a) so that on remand the District Court could make the appropriate findings free of such error.

[7] An eighth legal error found by the Federal Circuit was the District Court's failure to follow proper legal standards in construing the claims of the patent in suit. This error, however, is not at issue in Barnes-Hind's petition.

By relying on Mr. Hager's opinion, the District Court ignored the law that the issue of obviousness is determined with reference to a *hypothetical* person having ordinary skill in the art. The actual inventor's skill is irrelevant to the statutory analysis under 35 U.S.C. 103, because inventors "possess something—call it what you will—which sets them apart from the workers of *ordinary* skill., . . ." (Pet. 9a). (emphasis in original).

2. Failure to Construe The Caddell Patent As A Whole

In its Findings of Fact and Conclusions of Law, the District Court found:

> "(48) Thus, the concept of forming ridgeless depressions having smooth rounded edges in plastic using a laser beam to vaporize the material is explicitly disclosed in the Caddell patent. *That is exactly the same process in patent-in-suit and practiced by plaintiff.*" (F-48; Pet. 26a) (emphasis in original).

The Federal Circuit's opinion correctly points out that the District Court selected a single line out of the entire Caddell patent to support this finding (Pet. 10a), which was authored by Barnes-Hind (A7). In so doing, the Federal Circuit held (Pet. 10a-11a) that the District Court committed legal error by failing to observe established legal standards requiring that prior art patents be considered in their entirety including those portions of the patent which argue against obviousness.

3. Improper Hindsight Analysis In Concluding The Invention Was Obvious

The next legal error committed by the District Court was its resort to improper hindsight analysis in construing the Caddell patent and then reaching its

conclusion that the patent in suit was invalid for obviousness (Pet. 11a). Hindsight analysis occurs when the patent in suit is used by a court as a map to guide it through the maze of prior art, selecting bits and pieces from the prior art disclosures to reach a conclusion of obviousness that could not otherwise be made without the benefit of the patented invention.

4. Reliance On Dr. Brucker's Experiments, Which Were Not Prior Art, To Support The Obviousness Finding

During Bausch & Lomb's case in chief, it offered into evidence excerpted pages from the deposition of Dr. Brucker. Bausch & Lomb did this as a precaution because Barnes-Hind did not definitely state that it would call Dr. Brucker as a live trial witness right up to the day he appeared. However, when Barnes-Hind called Dr. Brucker and he gave his trial testimony, Barnes-Hind waived its right to use Dr. Brucker's deposition for any purpose except impeachment of his live testimony.

The Federal Circuit noted in its opinion (Pet. 11a) that the District Court relied on Dr. Brucker's experiments in laser marking contact lenses as further evidence of obviousness. However, Dr. Brucker testified at trial that he did not conduct his experiments until 1979 or 1980 (A49). Thus, these experiments were not prior art and there was no support for the District Court's finding that:

> "(91) Dr. Brucker's experiments in laser marking contact lenses are further evidence in support of this court's finding of obviousness." (F-91, Pet. 33a).

The Federal Circuit said:

> "This too was error, in this case clearly erroneous factual error. The record does not support, indeed it contradicts, the supposition that Dr. Brucker had engaged in laser marking of soft contact lenses at the time of the present invention." (Pet. 11a-12a).

5. Failure to Determine The Level of Skill In the Art

The Federal Circuit's opinion points out yet another legal error by the District Court in its failure to determine the level of ordinary skill in the pertinent art. Instead of determining the level of ordinary skill, the District Court relied on Mr. Hager's opinion and "misused that opinion as a substitute for determining the level of skill of the hypothetical person of ordinary skill. . . ." (Pet. 9a-10a).

6. Substituting a "Gist" or "Core" For The Invention Defined By The Claims

The next legal error committed by the District Court was its distillation of the invention down to a "gist" or "core", disregarding the claimed invention as a whole (Pet. 13a).

7. Failure to Observe The Presumption of Patent Validity

Another legal error spotted by the Federal Circuit was the District Court's failure to observe the statutory presumption of patent validity under 35 U.S.C. 282 (Pet. 6a-8a). Barnes-Hind's petition attempts to gloss over this fundamental legal error in its petition (Pet. 14), as if only the legal errors concerning the lack of *Graham* findings were the basis for the remand. Bausch & Lomb disagrees.

In its failure to observe the presumption of validity, according to the Federal Circuit, the District Court apparently did not consider separately the validity of the three claims in issue (Pet. 6a); it adopted Barnes-Hind's "misleading the examiner" theory which was not supported by the record (Pet. 6a-7a); and it did not recognize that when the prior art before the court is the same as that before the U.S. Patent and Trademark Office (such as the Caddell and Brucker patents in our case), the burden on the party asserting patent invalidity is more difficult to meet (Pet. 8a).

SUMMARY OF ARGUMENT

There are no "special and important reasons" to grant Barnes-Hind's petition within the meaning of Rule 17.1 of this Court. The District Court's judgment was vacated because it failed on more than seven occasions to apply the proper legal standards when reaching its findings. These legal errors are not subject to the "clearly erroneous" provisions of Rule 52(a). Moreover, the Federal Circuit did not make any findings but, instead, remanded that function to the District Court with instructions to follow the correct principles of law.

ARGUMENT

There Are No Special and Important Reasons For This Court to Grant Certiorari.

This Court has long made it clear that certiorari should be granted "sparingly, and only in cases of peculiar gravity and general importance, or in order to secure uniformity of decision." *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U.S. 251, 258 (1916); *Rice v. Sioux City Memorial Park Cemetery, Inc.*, 349 U.S. 70, 74 (1955).

The petition should be denied because it totally lacks any "special and important reasons" for granting it, as required by Rule 17.1 of this Court. Specifically there is no conflict between the judgment of the Federal Circuit for which review is sought and any decision of another Court of Appeals, nor has the Federal Circuit in its judgment "so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this Court's power of supervision," as set forth in Rule 17.1(a) of this Court.

The District Court's Judgment Was Vacated Because of Several Legal Errors Which Are Not Subject To Rule 52(a).

The Federal Circuit's opinion (Pet. 1a) is quite clear that the basis for vacating the District Court judgment was legal error. This Court on numerous occasions has held that if the trial court bases its findings upon an erroneous view of controlling legal standards, the "clearly erroneous" provision of Rule 52(a) does not apply, and the findings may not stand. *United States v. Singer Manufacturing Co.*, 374 U.S. 174, 194, n.9 (1963).

Since the Federal Circuit's basis for vacating the District Court's judgment was legal error, and not *de novo* fact finding, Barnes-Hind's reliance on this Court's decisions in *Anderson v. Bessemer City*, 470 U.S. 564 (1985) and *Icicle Seafoods, Inc. v. Worthington*, 475 U.S. _____, 106 S. Ct. 1527, 89 L. Ed.2d 739 (1986) is misplaced.

The Federal Circuit Did Not Make Its Own Subtest Finding Regarding "Teaching Away".

Barnes-Hind's petition (Pet. 17) confuses this Court's decision in *United States v. Adams*, 383 U.S. 39 (1966) concerning the patent law doctrine of "teaching away." In *Adams*, two kinds of "teaching away" principles are discussed. The first involves an expressed disbelief in the invention by noted experts. This is a secondary consideration of the type described in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), which argues against obviousness. The second type of "teaching away" described in *Adams* involves prior art references whose teachings lead away rather than toward the invention:

> "Despite the fact that each of the elements of the [patented] Adams battery was well known in the prior art, to combine them together as did Adams required that a person reasonably skilled in the prior art must ignore . . . [the long accepted factors of the prior art]. . . . These long accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by Adams. . . . We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness." *Adams*, 383 U.S. at 51-52.

Barnes-Hind's petition (Pet. 17) erroneously combines these two separate and distinct principles. The first teaching away principle concerning "expressed disbelief" in the invention by experts, a *Graham* secondary consideration, is not at issue in this case. The second principle concerning "known disadvantages in old devices" is involved in this case, particularly with respect to the Caddell patent.

In determining whether a prior art patent, such as Caddell, teaches away from the patented invention, correct legal standards must be followed. One of these legal standards provides that one may not pick and choose from a prior art patent only such much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what the patent fairly suggests to one skilled in the art (Pet. 10a). Another of these legal standards requires that the prior art patent be considered in its entirety without ignoring portions of the patent which argue against obviousness (Pet. 11a).

In vacating the District Court's judgment, the Federal Circuit held that the District Court did not follow these legal standards when considering the Caddell patent and, therefore, committed legal error (Pet. 10a-11a).

The Federal Circuit therefore remanded the case to the District Court to consider the Caddell patent in its entirety. The circumstance that the Federal Circuit commented "Caddell actually taught away from laser etching of soft contact lenses" (Pet. 11a) has been blown completely out of proportion by Barnes-Hind and apparently forms the entire basis for its petition. The Federal Circuit's observation concerning the Caddell patent, which was most likely intended to guide a very

misguided District Court, was not a factual finding of its own. The Federal Circuit was careful not to do this and fully understood its role:

> "This court, as an appellate court, may not make the required *Graham* factual findings, and must therefore remand that determination to the district court." (Pet. 12a).

On remand, the District Court is completely free to determine what the Caddell patent teaches and what it does not, so long as the proper legal standards enunciated by the Federal Circuit are followed in reaching that determination. Barnes-Hind's cry of *de novo* fact finding by the Federal Circuit contrary to Rule 52(a) has no basis in law or fact.

CONCLUSION

All of these legal errors discussed above compelled the Federal Circuit to vacate the District Court's judgment and to remand for new findings following the correct legal standards. There was no independent fact finding by the Federal Circuit as Barnes-Hind claims. Hence, there is no parallel to the *Dennison* petition.

It is respectfully requested that the petition be denied.

Respectfully submitted,

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APPENDIX

Defendants' Revised Proposed Findings of Facts

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United States District Court
District of Northern California

Civil Action No.
83-20283 (RPA)

Appendix—Defendants' Revised Proposed Findings of Facts.

BAUSCH & LOMB INCORPORATED,
a corporation,

Plaintiff,

v.

BARNES-HIND/HYDROCURVE, INC. and BARNES-HIND INTERNATIONAL INC.,
a corporation,

Defendants.

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[1] I. *DEFENDANTS' REVISED PROPOSED FINDINGS OF FACTS*

Background

(1) Defendants are engaged in the business of manufacturing various types of contact lenses including hard and soft lenses.

(2) A hard contact lens is made of a material relatively impermeable to fluid or gas molecules. A hard contact lens, as its name implies, is normally in a hard or rigid state.

(3) A soft contact lens is made of a material capable of absorbing fluid. In an unhydrated state, i.e. containing no water, a soft contact lens is rigid much like that of a hard lens. In its hydrated state, however, a soft contact lens is soft or pliable.

(4) Within the general category of hard and soft contact lenses, there are lenses which are designed to correct specific eye disorders such as astigmatism. Astigmatism may be corrected through the use of "toric" type contact lenses.

(5) Toric lenses differ from conventional contact lenses in that they are thicker at one edge portion of the lens. This thickened portion is referred to as the prism base of the lens.

[2] (6) In order for a toric lens to be properly fitted on an astigmatic patient, it is helpful that the fitter be able to locate and identify the central axis of the prism base. It is therefore desirable to mark the center axis of the prism base at the time the lens is manufactured.

(7) Toric contact lenses were first offered commercially in the mid-1970's; the demand initially was relatively small. In view of the small demand, the mark was applied using a mechanical tool or drill.

(8) In the late 1970's and early 80's the demand for soft toric lenses increased and automatic marking techniques became economically warranted; that is, a need for automatic marking arose when the demand for toric lenses justified the cost of such automation equipment.

The Patent-in-Suit

(9) U.S. Patent 4,194,814 issued on March 25, 1980 from an application, serial number 853,133, filed on November 10, 1977.

(10) The named patentees of the patent-in-suit are David Fisher, James A. McCandless and James D. Hager.

(11) The patent-in-suit is owned by plaintiff, Bausch & Lomb Corporation, which it acquired when it purchased the Milton Roy Company.

Appendix—Defendants' Revised Proposed Findings of Facts.

[3] (12) The patent in suit claims a contact lens formed of a transparent cross-linked polymer material which includes a mark on its surface made by a laser, including a process for making such lens.

(13) The claims require that the area contiguous to the mark is smooth and unaffected.

(14) The specification of the patent in suit indicates that the process is applicable to *any* contact lens, including hard and soft type lenses.

(15) The patent specification does not distinguish between different plastic lens materials with respect to the suitability of marking by laser.

(16) The Patent Office initially rejected all the claims as being "obvious" and therefore unpatentable over certain "prior art" patents, namely, U.S. Patents 3,833,786 (Brucker) and 3,549,733 (Caddell).

(17) The Caddell patent discloses the use of a laser to remove plastic from the surface of a printing plate to form a pattern.

(18) The Caddell patent discloses the partial penetration or etching of a plastic material; etching is the same as marking.

(19) The Brucker patent teaches the use of a laser to fenestrate, i.e. to make holes, in a plastic contact lens.

[4] (20) In view of the teaching of Caddell and Brucker, the Patent examiner concluded that it was "obvious" and, therefore, unpatentable to laser-mark the plastic contact lens disclosed in Brucker to a partial depth as taught in Caddell.

Appendix—Defendants' Revised Proposed Findings of Facts.

(21) In response to the examiner's rejection based on obviousness, plaintiff narrowed the scope of the patent claims by adding the limitations that the plastic material was "transparent" and "cross-linked" and further that the area surrounding the mark was "smooth" and "unsublimated", or "smooth" and "unaffected".

(22) In that same response, plaintiff urged allowance of the narrowed claims on the ground that while the non-cross-linked material disclosed by Caddell tended to melt and form a ridge around the depression, the cross-linked material recited in the claims vaporized when struck by the laser beam so that no ridge was formed around the depressed (i.e. etched) area.

(23) With respect to the non-cross-linked compound disclosed by Caddell (Delrin) which did not form a ridge when melted, plaintiff argued that the material was not transparent and was, therefore, unsuitable for use as a contact lens.

(24) Plaintiff also argued that the Brucker patent was limited to fenestrating "hard" contact lens and was, therefore, not relevant to his claimed (soft) contact lens.

[5] (25) Notwithstanding the above arguments, on May 24, 1979, the examiner again and finally rejected the claims based on the Caddell and Brucker patents.

(26) Plaintiff then had a personal interview with the examiner and after the interview, the examiner allowed the claims.

(27) In an Official Letter to plaintiff, the examiner indicated that he was allowing the claims because the prior art did not disclose specifically the "transparent cross linked . . . having smooth surface of unsublimated polymer".

(28) Based on this distinction, the patent issued.

The Brucker Patent

(29) The Brucker patent discloses a method of laser fenestration of contact lenses. The Brucker patent is applicable to cross-linked and non-cross-linked lens materials.

(30) The Brucker patent teaches that the fenestration of a contact lens using a laser results in a hole, the edges of which are "smooth and polished".

(31) The difference between partially penetrating, i.e., marking, and completely penetrating, i.e., fenestrating, is a mere difference in degree and a matter of choice.

(32) Plaintiff misled the examiner when he argued that Brucker was limited to "hard" lenses, and implied that hard lenses were non-cross linked. In fact, the Brucker lenses [6] were commercially sold and were made of cross-linked material; the laser made holes were also surrounded by smooth and unsublimated surface. If the Examiner was not misled and had correctly understood the Brucker disclosure, he could not have allowed the patent in suit for the stated reason (see page 28).

The Caddell Patent

(33) The Caddell patent is directed to surface etching plastic printing plates using a laser.

(34) The Caddell patent explains that to produce a printed plate of high quality, the formation of ridges around the etched patterns must be avoided.

(35) The Caddell patent further explains that the plate should be smooth except in the area of the depression.

(36) The Caddell patent teaches two ways of achieving a ridgeless depression; the first is to use a laser beam having a high enough intensity to *vaporize* the material without melting it, and the second is to use a material such as Delrin which tends to leave sharp edges when *melted.*

(37) The Caddell patent also teaches that when using a laser beam having an intensity sufficient to vaporize plastic material, some melting and therefore "rounding" of the edges would occur which is unsatisfactory in a printing plate. The rounded edges are, however, most desirable in a contact lens.

[7] (38) Thus, the concept of forming ridgeless depressions having smooth rounded edges in plastic using a laser beam to vaporize the material is explicitly disclosed in the Caddell patent. That is exactly the same process claimed in the patent-in-suit and practiced by plaintiff.

(39) The examiner allowed the patent over Caddell only because plaintiff urged upon the examiner the unfounded and contrived distinction between cross-linked and non-cross-linked materials, and the false arguments regarding the propensity of non-cross-linked materials to form a ridge.

Prior Work in the Contact Lens Industry

(40) In about 1960 Donald Brucker formed a company known as Continuous Curve.

Appendix—Defendants' Revised Proposed Findings of Facts.

(41) The business of Continuous Curve from 1960 to approximately 1970 was primarily the manufacture and sale of hard contact lenses.

(42) In the early 1970's Continuous Curve began experimentation with the use of soft contact lenses.

(43) In the early 1970's, Brucker developed and commercialized a process known as LASER-CON for laser fenestrating contact lenses.

(44) The purpose of fenestrating a contact lens was to aid in the circulation of pre-corneal fluid which is a natural result of blinking.

[8] (45) Brucker commercially fenestrated hard contact lenses which were made of a plastic material known as poly methyl methacrylate (PMMA).

(46) The PMMA lens material that Brucker fenestrated was manufactured and sold by the Glasflex Corporation located in Stirling, New Jersey under the tradename Glasflex. The Glasflex material fenestrated by Mr. Brucker using the Laser-Con process was a cross-linked material.

(47) The Laser-Con process was not limited to hard contact lenses; rather it could be used to fenestrate both hard and soft contact lenses.

(48) The holes produced by the Laser-Con process had smooth and rounded edges at both the posterior and anterior surfaces.

(49) In addition to the hard lenses which Continuous Curve commercially fenestrated using a laser, it fenestrated and surface-marked soft contact lenses made of a material known as poly hydroxyethyl methacrylate (PHP) for clinical use.

Appendix—Defendants' Revised Proposed Findings of Facts.

(50) PHP is a cross-linked polymeric material.

Work by Milton Roy Prior to the Filing of the Patent-in-Suit

(51) Milton Roy Company began producing soft contact lenses in approximately 1974 and received FDA approval to sell those lenses in 1976.

(52) From 1974 to 1976 the Milton Roy Company was not marking its soft contact lenses in any manner.

[9] (53) In February 1976 the Production Manager of Milton Roy Company, Mr. James D. Hager, (one of the patentees), saw an advertisement from a company called Lumonics who was in the business of laser marking a wide variety of materials and products including plastics.

(54) The Lumonics advertisement indicated that the laser produced a mark which was nonerasable, non-contacting, applied no printing force to the work piece; was capable of high production rates and introduced no foreign matter or possible contaminates to the work piece.

(55) The advertisement further indicated that the laser could produce extremely small and highly detailed marks even on products which were difficult to mark such as those which were uneven and fragile.

(56) Inspired by this advertisement, Mr. Hager, on April 8, 1976, forwarded six (6) lenses to the Lumonics Company requesting that those lenses be marked. The lenses were made of cross linked material.

(57) Lumonics marked those lenses and returned them to Mr. Hager.

(58) Upon their return and examination by Mr. Hager, the lenses were found to be satisfactory.

(59) Up to that event, Mr. Fisher and Mr. McCandless, the other named patentees, contributed absolutely nothing to the subject matter of the patent in suit.

[10] (60) Mr. Hager left the employ of Milton Roy in approximately September 1976.

(61) At no time did Mr. Hager or the other named inventors attempt to laser mark or have Lumonics laser-mark a non-cross-linked contact lens.

(62) On September 15, 1977, prior to filing the application which led to the patent-in-suit, Mr. Hager was requested by Milton Roy to execute the proposed application.

(63) In a letter dated September 30, 1977 Mr. Hager declined to execute the proposed application stating that he did not feel he had invented anything in connection with laser marking contact lenses and specifically that he did not believe any of the results he had obtained were unexpected.

(64) Notwithstanding Mr. Hager's belief, Milton Roy filed the proposed patent application on November 10, 1977.

(65) On August 12, 1982, after receiving the Notice of Allowance of the patent-in-suit the attorney for Bausch & Lomb Inc. contacted Mr. Hager and requested him to join as an inventor.

Appendix---Defendants' Revised Proposed Findings of Facts.

(66) In a letter dated August 12, 1982, the attorney for Bausch & Lomb, Inc. stated that Milton Roy's attorney had filed a prior art statement. Mr. Hager, however, was never given a copy of the patents included in the prior art statement nor the patents cited by the examiner.

[11] (67) Mr. Hager was never advised of the arguments made by Milton Roy's attorney to the Patent examiner.

(68) After receiving a check in the amount of $610, for "consulting services", Mr. Hager executed the necessary Declaration and Power of Attorney and Assignment papers.

(69) Mr. Hager, even as of the date of his pre-trial deposition, did not believe he made any "invention" or that laser marking was an "invention".

Defendants' Development of The Laser Marked Lenses

(70) Mr. John Jakoski, Vice President of Manufacturing of Barnes-Hind/Hydrocurve, was primarily responsible for defendants commercialization of its laser marked toric lenses.

(71) Prior to his employment with Barnes-Hind/Hydrocurve (previously known as Continuous Curve), he was employed for 14 years by Ocular Products as a product manager for prescription contact lenses.

(72) In the late sixties and early seventies, during his employment with Ocular Plastics, Mr. Jakoski became aware of the Laser-Con process used by Brucker in laser fenestration of lenses.

(73) During his employment with Ocular Products, Mr. Jakoski discussed the use of a laser to mark lenses, however, Ocular Products did not develop such a project because of a [12] lack of volume to justify the expense of purchasing laser marking equipment.

(74) In about 1976, a technician at Continuous Curve showed Mr. Jakoski one or two soft lenses which were laser marked with a circular dot to differentitate the right and left lens.

(75) In approximately the middle of 1979, defendants commercialized their first soft toric lenses under the tradename Hydrocurve II_{45} (45 represents the percentage of water contained in the lens material). The initial marking was made by using a mechanical tool. The mechanical tool was used for marking until about March of 1982, at which time the volume of sales made it commercially feasible for Barnes-Hind/Hydrocurve to change over to an automated system.

(76) In about November of 1981, Barnes-Hind/Hydrocurve also commercialized a second line of toric lenses under the tradename Hydrocurve II_{55}. The marks for those lenses were applied using a laser.

(77) From November 1981 until March 1982, Barnes-Hind/Hydrocurve was using both the mechanical tool and the laser for marking toric lenses.

[13] (78) In 1978, Mr. Jakoski knew that another company called Sauflon was laser-marking soft contact lenses. Thus, knowledge of another company using the laser marking process could not have been the motivation for defendants to use such process as they

did not begin to use such process until November of 1981 when the volume of sales justified the expense of the laser marking equipment.

(79) Barnes-Hind/Hydrocurve did not copy the idea of using a laser to mark soft contact lenses from plaintiff nor its predecessor company, Milton Roy. Brucker who had been using a laser for many years prior to the patent in suit testified that the use of a laser to mark a lens, either soft or hard, was always present in his mind. There was simply no earlier need to use the laser marking process; when the need arose, it was the obvious process to use.

Non-Infringement

(80) Plaintiff alleges that the HYDROCURVE II soft contact toric lenses infringe claims 1, 2 and 7 of the patent in suit.

(81) Claim 1, as well as claim 2, which is dependent from claim 1, is limited to a lens which has a "smooth surface of unsublimated polymer material" surrounding the laser marks.

(82) Claim 7, the process claim, also requires that the area surrounding the laser mark is "smooth and unaffected" by the laser radiation.

[14] (83) The laser engraved depressions in the surface of the HYDROCURVE II lenses have been examined by scanning electron microscope. These photographs show that the surface of these lenses surrounding the laser mark are not "smooth and unsublimated" or "unaffected" as those terms were defined by plaintiff during the processing of the patent in suit.

Appendix—Plaintiff's Trial Exhibits.

Plaintiff's Trial Exhibits

[34] PLAINTIFF'S EXHIBIT 2

Mail Room
Nov 10 1977
Pat. & Trademark Off.

In re Application of DAVID J. FISCHER, JAMES A. McCANDLESS and JAMES D. HAGER

Title: MEANS AND METHOD FOR MARKING TRANSPARENT OPHTHALMIC CONTACT LENSES

DECLARATION UNDER 37 CFR 1.47(a)

EDWARD DE LONG, Secretary of the MILTON ROY COMPANY of St. Petersburg, Florida, a corporation of Pennsylvania, declares and says as follows that:

Upon advice of counsel it is believed that JAMES D. HAGER is a co-inventor of the subject matter disclosed and claimed in the accompanying patent application entitled MEANS AND METHOD FOR MARKING TRANSPARENT OPHTHALMIC CONTACT LENSES and which bears attorney's docket no. MR-213;

The said JAMES D. HAGER was from June 5, 1972 to July 1, 1975 employed by MILTON ROY COMPANY;

On or about July 1, 1975 the said JAMES D. HAGER was transferred to MILROY/AUTOMATED, INC., a joint venture corporation of which one-half ownership was vested in said MILTON ROY COMPANY and one-half ownership in AUTOMATED OPTICS, INC.;

On or about November 11, 1975 MILTON ROY COMPANY acquired the entire interest of AUTOMATED OPTICS, INC. in MILROY/AUTOMATED, INC. including all right and title to technology, inventions and other similar rights and assets of MILROY/AUTOMATED, INC. and continues to own such rights and assets;

On or about November 11, 1975 the name of MILROY/AUTOMATED, INC. was changed to MILTON ROY SOFT CONTACT LENS, INC.;

On or about August 27, 1976 the said JAMES D. HAGER [35] resigned from MILTON ROY SOFT CONTACT LENS, INC.;

Pursuant to a document entitled "Non-Disclosure and Assignment Agreement Relating To Inventions, Patents and Confidential Information" executed by said JAMES D. HAGER on July 1, 1975, a copy of which is denominated Exhibit A and attached hereto, the said JAMES D. HAGER assigned and transferred any and all inventions made during his business association with MILROY/AUTOMATED, INC. which were along the lines of the business, work or investigations of the corporation, or which result from or are suggested by any association with the corporation;

On information and belief the contribution to the invention claimed and disclosed in the subject patent application was in fact along the lines of the business, work or investigations of MILROY/AUTOMATED, INC., and is in fact along the lines of the business, work and investigations of MILTON ROY SOFT CONTACT LENS, INC. and MILTON ROY COMPANY;

Title and ownership to, and rights in and to, any and all inventions of MILROY/AUTOMATED, INC. have been transferred to and vested in MILTON ROY COMPANY;

Accordingly the MILTON ROY COMPANY has a substantial proprietary interest in the invention of the above-captioned patent application;

On information and belief said JAMES D. HAGER is now employed by Sauflon International of 305 North Oak Street, Inglewood, California;

On information and belief said Sauflon International is engaged in the development of soft contact lenses and possibly of apparatus adapted to practice the instant invention, and to that extent is considered to be a competitor of MILTON ROY COMPANY and/or MILTON ROY SOFT CONTACT LENS, INC. or, upon information and belief, is expected to become a competitor of MILTON [36] ROY COMPANY and/or MILTON ROY SOFT CONTACT LENS, INC. in the near future, and accordingly the obtaining of a filing date for the instant patent application is necessary to preserve the rights of MILTON ROY COMPANY and to prevent irreparable damage thereto;

Upon information and belief the last known address of the co-inventor JAMES D. HAGER is 726 Idaho Street, Apt. 105, Santa Monica, California 90403;

Upon the completion of the above-mentioned patent application a declaration, power of attorney and petition, and assignment, were duly executed by DAVID J. FISCHER and JAMES A. McCANDLESS;

The papers were then forwarded to the said JAMES D. HAGER at 726 Idaho Street, Apt. 105, Santa Monica, California 90403, on or about September 15, 1977

accompanied by a cover letter, a copy of which is attached hereto and designated Exhibit B;

JAMES D. HAGER refused to execute the declaration, power of attorney and petition, and the assignment, on the grounds that in his opinion the invention was not patentable for obviousness, which fact is attested to by a copy of a letter dated September 30, 1977 and received from said JAMES D. HAGER, designated Exhibit C and attached hereto;

Accordingly, and as advised by counsel and in order to preserve its rights and prevent irreparable damage, co-inventors DAVID J. FISCHER and JAMES A. McCANDLESS have proceeded under 37 CFR §1.47 of the Patent and Trademark Office Regulations to make application for patent on behalf of and as agent for said JAMES D. HAGER.

The undersigned further declares that all statements made herein of his own knowledge are true and that all statements [37] made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

EDWARD DE LONG
Edward DeLong
Secretary
MILTON ROY COMPANY

Date: October 21, 1977

[42] EXHIBIT C

September 30, 1977

Dr. Earl J. Serfass, Ph.D.
c/o Milton Roy Company
5000 Park Street, North
St. Petersburg, Florida 33733

Dear Dr. Serfass:

I have received your letter of September 15, along with the patent application and the documents you requested me to sign.

I regret that I cannot execute either the "Declaration, Power of Attorney, and Petition" or the "Assignment" in their present form. The reason I cannot sign these documents is that I do not feel that I have invented anything in connection with laser marking of contact lenses. Therefore, I feel that I cannot execute documents, under oath or otherwise, that represent the contrary.

Additionally, there are statements in the patent application that I do not agree with, including, for example the statement that "It has unexpectedly been discovered . . ." on page five of the application. The results I obtained were not unexpected. I filled out a "Disclosure of Invention" only after you requested it and not because I believed the process to be patentable.

I am not contesting Milton Roys' right to attempt to patent anything it believes is patentable, and I would not hesitate to sign any documents for Milton Roy releasing any claim of invention in connection with the subject application, that do not require me to make a representation which I do not hold or believe.

I am returning with this letter the check and the documents that you sent me.

Sincerely yours,

JAMES D. HAGER
James D. Hager

Enclosure

Received
Oct 10 1977
Woodcock, Washburn
Burtz & Mackiewicz

[104] DECLARATION AND POWER OF ATTORNEY

JAMES D. HAGER declares that he is a citizen of the United States of America, residing at 9441 Garibaldi Avenue, Temple City, California 91780; that on November 10, 1977, under the provisions of Patent and Trademark Office Rule '37 CFR 1.47(b), Patent Application Serial Number 850,133, entitled "MEANS AND METHOD FOR MARKING TRANSPARENT OPHTHALMIC CONTACT LENSES" was filed claiming me to be a joint inventor with David J. Fischer and James A. McCandless but without my signature by a corporation claiming an interest therein; I now join in that application, I have read the foregoing described specification and claims as filed and I verily believe I am the original, first and joint inventor of the invention in "MEANS AND METHOD FOR MARKING TRANSPARENT OPHTHALMIC CONTACT LENSES" (Case MR-213) described and claimed in the said specification; that I do not know and do not believe that this invention thereof, or patented or described in any printed publication in any country before our invention thereof, or more than one year prior to this application; or in public use or on sale in the United States more than one year prior to this application; that this invention has not been patented in any country foreign to the United States on an application filed by us or our legal representatives or assigns more than twelve months before this application; and that no application for patent on this invention has been filed by us or our representatives or assigns in any country foreign to the United States, except as follows:

None

And we hereby appoint Frederick W. Powers, III, Registration No. 25,455, of the firm of Woodcock, Washburn, Kurtz & Mackiewicz, 1800 United Engineers Building, 30 South 17th Street, Philadelphia, Pennsylvania 19103 our attorneys to prosecute this application and to transact all business in the Patent Office connected therewith.

Wherefore we pray that Letters Patent be granted to us for the Invention or discovery described and claimed in the foregoing specification and claims, and we hereby subscribe our names to the foregoing specification and claims, declaration, power of attorney, and this petition.

[105] The undersigned petitioners declare further that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor	JAMES	D.	HAGER
	First Name	Middle Initial	Last Name
	James	D.	Hager

P.O. Address 9441 Garibaldi Avenue, Temple City, CA 91780

Date Sept. 13, 1982

[139] Serial No. 850,133
Art Unit 257

-2-

Claims 14-23 are rejected under 35 USC 103 as unpatentable over Brucker in view of Caddell for reasons of record set forth in paper number 8. Applicants arguments have been considered, but are not persuasive. Applicants argue that the polymer Delrin, considered by Caddell, is not linear or crosslinked and hence, cannot be suitably utllized as a lense material. It should, however, be pointed out that the ordinary skilled contact lense worker would consider all lense materials cross linked, non-cross linked, linear, non-linear, hydrophilic, hydrophobic, etc.

This action is made *FINAL*.

JOHN K. CORBIN
John K. Corbin
Supervisory Patent Examiner
Group Art Unit 257

SJS
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(703) 557-2884
5/10/79

Appendix—Plaintiff's Trial Exhibits.

PLAINTIFF'S EXHIBIT 40

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

BAUSCH & LOMB INCORPORATED,
a corporation,

Plaintiff,

vs.

BARNES-HIND/HYDROCURVE, INC.,
a corporation, and BARNES-HIND
INTERNATIONAL, INC., a corporation,

Defendants.

No. C 83 20283

DEPOSITION OF: JAMES D. HAGER
TAKEN ON: May 1, 1984

Case No. C 83 20283 RPA
Bausch & Lomb Incorporated
vs. Barnes-Hind/Hydrocurve
Plaintiff's Exhibits 40
Date_____Iden.
Date_____Evid.
By_____
AO38E Deputy Clerk

[10] EXAMINATION

BY MR. CALIMAFDE:

* * *

Q. Now, prior to Dow, were you employed?

A. Yes.

Q. By whom?

A. A company called Sauflon, S-a-u-f-l-o-n, International.

Q. For how long were you employed by them?

[11] A. 1976 to '79.

Q. In what capacity?

A. As production manager.

Q. Were they in the business of manufacturing ophthalmic lenses?

A. Yes, they were.

Q. Contact lenses?

A. Yes.

Q. Hard?

A. No, soft.

Q. Only soft?

A. Yes.

Q. As production manager, what were your responsibilities?

A. Very similar. Supervise the production of the lenses themselves.

Q. At Sauflon, were the lenses marked?

A. Yes, they were.

Q. How were they marked?

A. With a Lumonics laser.

Q. Was Sauflon marking the lenses prior to the time you joined them?

A. No.

Q. Was that something you introduced?

A. Yes.

Q. Do you recall about when you introduced that method of marking?

A. That would be some time in early '77.

[13] * * *

Q. Prior to 1976, prior to joining Sauflon, were you employed?

A. Milton Roy Corporation.

Q. For how long were you employed by Milton Roy?

A. Seven years.

Appendix—Trial Testimony, Excerpts of Plaintiff's Witnesses.

Trial Testimony, Excerpts of Plaintiff's Witnesses

[10] TESTIMONY OF ROBERT MANDELL

DIRECT EXAMINATION

BY MR. PRETTY:

* * *

Q All right.

Your Honor, I would like to offer Dr. Mandell as Plaintiff's Expert Witness on contact lenses.

Mr. Calimafde: No objection, Your Honor.

The Court: All right. There being no objection, the court finds by virtue of his education, training and experience Dr. Mandell qualifies as an expert on contact lenses and related matters.

Now, are you certifying him or asking him to be certified as an expert on the manufacture of contact lenses or what area specifically of contact lenses?

Mr. Pretty: Well, he will be describing primarily the marking of contact lenses and the fitting of contact lenses.

The Court: The marking and fitting.

Mr. Pretty: And also some testimony of the prior art as it relates to his areas and initially commenting on the smoothness of contact lenses. Incidentally, he does know something, quite a lot about the manufacture of lenses and questions may fringe into that area.

The Court: All right. Well, I will hear you if you have some objections.

Mr. Calimafde: I am not sure it's an objection, Your Honor. I didn't understand that Dr. Mandell, as a [11] result of the brief period when he gave his credentials was being offered as an expert other than as one in physiological optics and perhaps a doctor who is familiar

with problems that might occur from improperly fitted lenses or improperly marked lenses. And that was about the extent of it. I didn't know he was being offered as a person with expertise in the manufacturing or in the mechanics of marking a lens.

The Court: All right. There's two areas wherein I think you may require some further showing of expertise and that is in the area of marking and in the area of prior art. Now, in the area of smoothness, certainly in physiological optics he would be familiar with smoothness because necessarily he certainly would want to check for any rough edges on the cornea, but these other two areas, prior art and marking, I think you should elicit more expertise if any from him. (Tr. 10-11).

[32] * * *

Q Now, going to a new topic, have you designed any contact lenses yourself?

A Yes.

Q And I think you referred earlier to the fact that you have your own laboratory and lens-making equipment for making experimental lenses. Could you describe that laboratory in a little more detail and also your ability to manufacture lenses.

A Well, I have just a very small laboratory with the essential equipment that's required for making a contact lens. I have two lathes. There is apparatus for blocking and holding the lens. Finishing the lens, edging the lens.

Mr. Calimafde: I'm sorry, etching or edging?

The Court: E-d-g-i-n-g?

The Witness: Right. I'm sorry.

Q (By Mr. Pretty) Have you personally made prototypes of lenses that you described in your laboratory?

[33] A Yes, I generally use this lab just for experimentation and designing of lenses.

Q Had you designed any contact lenses by 1976?

A Yes.

Q How many?

A Half a dozen or so.

Q Could you describe each of those types of contact lenses that you designed?

A I designed a bifocal contact lens about '64, '65, for Contour Contact Lens Company. I designed a lenticular lens—I don't know if I need to describe the details of what that is—but also for Contour Contact Lens Company. I designed a second bifocal for Concise Contact Lens Company somewhere around '69 or '70. I designed the lens we call the gravity lens for the same company. I also designed an ultra-thin lens design where I introduced the use of computers for design around '73. I designed a number of other minor lenses for the same company.

Q That's for Concise?

A Yes.

Q Any other companies for whom you have designed lenses?

Mr. Calimafde: Your Honor, I'm not sure I understand the relevancy of this. I had expected to hear about marking these lenses.

The Court: It may be preliminary to asking him some questions on the design.

Mr. Pretty: It's going to his level of skill, Your Honor.

[34] The Court: All right, fine.

Mr. Pretty: You may answer.

The Witness: I'm sorry, what was the question?

Q (By Mr. Pretty) I was going to ask if there were any other companies—you mentioned Contour Contact Lenses and Concise Contact Lenses. Any other companies?

A This is before '76?

Q Right.

A I can't remember the exact date. I actually did some work for Continuous Curve with Dr. Brucker somewhere around that date. I can't remember exactly.

Q Have any of these designs gone into commercial production?

A Most of them are still in commercial production.

Q Are you a named inventor on any patent relating to contact lenses?

A Yes. I neglected to include that in the lenses I designed. Nineteen—about 1970 I was a co-inventor of a contact lens in which I did all the design work, physical design work for the lens—

Q And—

A —Excuse me. I actually made the earlier forms of the lenses.

Q In your lab?

A Yes.

Q Now, by 1976 and how long had you been involved in fulltime, professionally, in the field of contact lenses?

A In 1976, twenty years.

[35] Q Do you know any other contact lens designers?

A Yes.

Q What background do these lens designers have?
A Most lens designers were optometrists, many of them had some engineering background or some background in machining. And they were generally self-taught or learned from other manufacturers.
Q Do you know of any designers of a contact lens in or about 1976 who came from the field of laser technology?
A No. (Tr. 32-35).

* * *

[53] CROSS EXAMINATION

BY MR. CALIMAFDE:

* * *

Q Now, it was known prior to November, 1977, and so that there's no mystery about that date, that is the filing date of the patent and suit was November 10, 1977, so if I ask you questions about things which occurred to your knowledge prior to November 10, 1977, I have picked that date because it is the filing date of the patent and for no other reason.

Now, it was known prior to that date to drill a hole through a lens using a mechanical drill. Isn't that true, sir?
A Yes.
Q And it was known prior to that date to drill a hole through a lens using a laser. Isn't that true, sir?
A Yes.
Q Now, it was known prior to that date to mark the surface of a lens using a drill but going only partway into the thickness of the lens. Isn't that true?
A Yes.

Q And wouldn't it be—have been the most obvious thing in the world to have taken the laser which has gone all the way through the lens to use it to go only partway through the lens as you did with the drill?

A If you knew a laser was capable of doing that.

Q And that was all that was missing in the equation to your knowledge, that a laser was capable of going partway. Is that correct, sir?

A I would say that's the most important thing, yes.

[54] Q And isn't it a fact that it was known that a laser could be controlled to go partway through the thickness of plastic material?

A It wasn't known to me.

Q Ah. As a result of preparing for the, for your testimony in this case, was it known to those in the industry familiar with plastics and laser marking?

A In the contact lens industry or other industry?

Q Well, you said you reviewed the Caddell Patent.

A Yes.

Q If you look in your Defendant's Exhibit Book at the Defendant's Exhibit Number 4—do you have it, sir?

A Yes.

Q If you turn to the first page there is a page containing a number of exhibits. Do you see that—I'm sorry. A number of illustrations. A number of drawings. That's the first page of the patent, Exhibit 4, with the name Caddell at the top.

A Yes.

Q And just so that the record is clear, I'm looking at Patent Number 3549733 to a person named Caddell with two d's and two l's.

You're looking at the same patent as I, sir?

A Yes.

Q Now, if you turn to the first page of the written text, if you look at column 1 beginning at line 28. Beginning with the word "the depth"—do you see that?

A Yes.

[55] Q —"The depth of the depression can be selectively varied by modulating the intensity of the incident laser beam." Isn't it a fact, sir, that the Caddell Patent taught those skilled in the art that the depth of the depression, the marking can be controlled by controlling the intensity of the laser beam?

A Yes.

Q If that was known to you and to other people skilled in the art prior to November 10, 1977, then it is your testimony that it would have been obvious to mark the contact lens with a laser. Isn't that true, sir?

A You said it was my testimony. I don't believe I said that.

Q Is it your testimony that if it was known to the skilled person that the depth of the laser could be controlled, then it would have been obvious to use the laser to mark the lens?

A If I had known that I could do that with the materials that were used for a contact lens, yes.

Q Then you agree. And doesn't Caddell tell you that it was known and that he tells you in his patent that the depth of the laser penetration in plastic material can be controlled by varying the intensity of the laser beam?

A He tell us that but he also says that there's—

Q Well, please, sir.

Mr. Pretty: I object.

Q (By Mr. Calimafde) Doesn't he tell you that?

The Court: Just a minute.

Mr. Calimafde: Is my question—

[56] The Court: He may explain his answer.

You may explain your answer.

The Witness: He tells us that it is possible that that—but that it is only free of problems in one unique polymer and specifically excludes a group of other polymers, among which is Methyl Methacrylate which is used in contact lenses.

Q (By Mr. Calimafde) All right. Let's—let's take your answer and dissect it and analyze it—

The Court: Before you do that, let me take one of the answers and see if I could understand it.

You are saying that had you had the knowledge that the laser beam could be controlled in such a manner that you could regulate its depth of penetration into the lens for marking purposes, that it would then be obvious—

Mr. Calimafde: To use it.

The Court: —To use it.

The Witness: If I had known it would work on the material which is in the contact lens in that way.

The Court: Then it would be obvious to use this as another means of marking the lens?

The Witness: Yes.

The Court: But you said you did not know that at the time; therefore, it was not obvious to you.

The Witness: I said that and in addition I was at least implying that even if I had known about this patent, at the time the patent specifically excludes the type of material that is used in a contact lens as being [57] successfully treated by this process.

The Court: That's what you were just saying now and where did you find that?

The Witness: That's in column 6. Actually, beginning at the bottom of column 5. Actually, starting with the paragraph at line 49 where he begins to talk about the problems of this technique wherein he says that the problem of ridges—

The Court: You're talking about column 6, 49?

The Witness: I'm sorry. I'm talking about column 5, Your Honor.

The Court: Column 5, 49.

The Witness: Yes.

The Court: That would start with ideally.

The Witness: Yes.

The Court: All right.

The Witness: There he begins the discussion about the problems associated with this technique and the fact that the technique was only workable with this one particular material, Delrin, and that it was not workable with most other plastics including Methyl Methacrylate which is the plastic used in contact lenses, because it produced at the same time as the ridge, it produced an elevation surrounding that which negated the—the method.

The Court: All right. Thank you. (Tr. 53-57).

[61] * * *

Q He says, the term engraving generally means to form a depressed area in the surface of a material. It should be apparent that the procedure described herein is also applicable to drilling a hole directly through the material or to etch away a surface material to expose a layer of a different material below. In that sentence he is saying

that whether you drill a hole through or whether you surface-mark, you use the same procedure. Does he not, sir?

A Yes.

Q In our case the prior art such as a Brucker Patent is the drilling of a hole through and the Bausch and Lomb Patent is making a partial hole and in Caddell he says it's the same procedure whether you go through or whether you go partly through. Does he not in that sentence?

A Yes, but that's an important difference. In the [62] Caddell Patent he's working with a material and he emphasizes that this technique is only effective in the material that he refers to, so-called Delrin.

Q All right.

A Now, the big distinction is that the material that's, that he's talking about is not transparent. And when you shine a laser or a light on a material that's not transparent, you wouldn't expect it to go all the way through even like the analogy, if I shine a light at this board or anything in the room that isn't transparent, that light isn't going to go through that material. But if you're talking about a transparent material such as a contact lens, that light is going to go right through the material completely and it's a little difficult if you're not an expert in lasers to understand exactly how they stop that light at some point through that transparent material. And that to me is a very important difference between what he is doing here and what other people were doing with the contact lens. (Tr. 61-62).

* * *

[74] REDIRECT EXAMINATION

* * *

Q (By Mr. Pretty) Reading the paragraph which begins at line 49. Is Caddell in that paragraph, to your understanding, assuming one coming from the contact lens art and not the laser art, suggesting that Delrin is the practical way to go to avoid ridges?

A Yes.

Q Now, if you—I know that you did not read this back in [75] 1976, but if you had read this in 1976 and assume, one, in the contact lens art, what is the general teaching that you would have got from this patent?

A Would it be out of order, Your Honor, to ask for time to allow me to re-read this patent again, because I thought I understood this point.

The Court: I thought you made the point clear to me, because you needed to re-read it, because you just said that a moment ago, and we're pretty close to the noon hour and maybe you should re-read it.

The Witness: If I could do that.

The Court: All right. (Tr. 74-75).

* * *

[78] REDIRECT EXAMINATION (RESUMED)

BY MR. PRETTY:

Q Over the lunch recess have you had an opportunity to read that patent and satisfy yourself about it now?

A Yes, I have.

[79] * * *

Q Now, as I understand it, you were asked on your cross-examination if it would have been obvious to one of ordinary skill to take the material that was used by Mr. Brucker and use it in the process of Mr. Caddell to end up with a contact lens that wouldn't have ridges.

Do you recall a question of that nature?
A Yes, more or less.
Q What is your answer on that?
A I don't think it would have been obvious to take the [80] material that Dr. Brucker was working with at the time and apply the teachings of Caddell and come up with the etching process.
Q Could you explain the reasoning that you, that leads you to that conclusion?
A Well, the first reasoning is that it wasn't obvious to me to do it at the time. And I had knowledge—well, I didn't have knowledge of the Caddell Patent at the time. I had a certain limited knowledge about lasers. It was my impression looking at the process done by Dr. Brucker that it was not all that easy to control the amount of energy going through the laser, that it was sort of all or none process. You—you effectively burned a hole all the way through the material or nothing else. Now, having the knowledge of Caddell and reading the patent carefully, it's my impression that the techniques that Caddell describes in the patent were intended to apply to only a very limited number of materials related to Delrin, in the family of Delrin, and that this process did not work on other polymers including Methyl Methacrylate which was the material of the contact lens. (Tr. 79-80).

* * *

[355] TESTIMONY OF RONALD SALOVEY
CROSS EXAMINATION

By Mr. Calimafde:

* * *

Q Whether it's cross-linked or not cross-linked, it can be made to vaporize when subjected to sufficient heat?

A Whether it's cross-linked or not cross-linked, if it is heated high enough, again vaporization, there's that loose word, it can be thermally decomposed by heat and go into a gas form which loosely is called vaporization. Yes.

Q And the cross-linked goes into the gaseous form without melting and the noncross-linked goes into the gaseous form after the melting state. Generally that is what you are telling me, are you not? [356] A I disagree with that.

Q I'm sorry. I thought that is what I just understood.

A Could you say that again?

Q You indicated that both the cross-linked and the noncross-linked eventually can be vaporized and I thought you said that the cross-linked would not melt substantially and that would go into the vapor—the gaseous form when subjected to sufficient heat. But that the noncross-linked would go to the melt phase and then off to the gaseous phase. Is that correct?

A Okay. That is not correct. The reason it's not correct is because what I am doing is I take a cross-linked polymer and I am heating it so it begins to decompose. The consequence of the initial decomposition is that parts of it are broken off. These parts are linear fragments which melt. In fact, I would predict that the cross-links are less stable than the backbone of the linear polymer. And so a consequence of heating them to very high temperatures would be that I would break the cross-links. So before I vaporize, I convert a cross-linked polymer in local regions to a linear polymer and then that melts.

Shall I amplify?

The Court: No, I understand what you are saying, it's different from what he is saying. (Tr. 355-356).

Appendix—Trial Testimony, Excerpts of Defendant's Witnesses.

Trial Testimony, Excerpts of Defendant's Witnesses

[393] TESTIMONY OF RICHARD MILLER

DIRECT EXAMINATION

By Mr. Calimafde:

* * *

Q '76. And then prior to 1976 were you employed?
A Yes.
Q By whom?
A Motorola.
Q What was your job at Motorola?
A Laser engineer for all the divisions of Motorola—

The Court: Which division?

The Witness: All of them. I was the laser engineer and I was put on various tasks for many of the divisions.

Q (By Mr. Calimafde) What kind of work did you do as a [394] laser engineer for Motorola?
A I would oversee the development of laser systems for production of products that Motorola manufactures, such as semiconductor manufacturing.
Q And how was the laser used in connection with semiconductor manufacturing?
A The laser was used to scribe silicon material, wafers, transistors, diodes.
Q When you use the word scribe—
A Scribe is to etch a line into the surface of the variable, some specific depth but not all the way through the wafer.
Q All right. You mean or did you mention a printed circuit board at Motorola?
A No.

Q What types of products did you scribe for Motorola by the laser?
A Primarily silicon, and some other semiconductor materials—
Q And do you know for what purpose those semiconductor materials were used?
A Yes, manufacturing transistors, diodes, and integrated circuits.
Q How long were you with Motorola?
A Four and a half years.
[395] Q That takes us to 1971 to about 1976.
A Yes.
Q And prior to 1971 were you employed?
A Yes.
Q By whom, sir?
A Quantronics Corporation.
Q What kind of work did you do for Quantronics?
A I was a laser engineer.
Q What was the business of Quantronics?
A Designing and building laser machines for the—a variety of industries but primarily the semiconductor industry.
Q What was your job as a laser engineer for Quantronics?
A I did—I did the application skill work for the company on materials for contracts that the company had with their customers to find out if the laser was suitable to process various kinds of materials.
Q What kinds of materials?
A Semiconductors, plastics, ceramics, printed circuit boards, metals, and that's the majority of it.
Q And what purpose would the laser be used for in connection with these materials?

A The laser was used to drill, cut, weld, scribe, mark the materials.

Q How long were you with Quantronics?

[396] A Since '67.

Q So that from 1967 to 1971 you were with Quantronics.

A Yes.

Q And in '71 you went to Motorola.

A Yes.

Q Prior to 1967 were you employed?

A Yes.

Q By whom?

A TRW, Incorporated.

Q And what kind of work did you do for TRW?

A I was a laser engineer.

Q And again what kind of work did you do as a laser engineer?

A I helped in the design and fabrication of lasers. It would be laser primarily.

Q For what kind of application?

A Drilling, cutting, welding. (Tr. 393-396).

[397] * * *

Q Now, let me take you to the period prior to 1977. All right, sir. What type of—types of materials had you actually marked with a laser?

A Semiconductors. Plastics. Some metals. As far as marking or scribing, one additional one, ceramics.

(Whereupon, at this time there was off-the-record discussion.)

The Court: All right. He was saying that he had marked semiconductors, plastics and some metals. So do you want to pick up from there again?

Q (By Mr. Calimafde) Did you mark glass, for example, materials like that, wood, leather, any other materials?
A I did most all those materials afterwards, but not prior.
Q Not prior to '77?
A No.
Q So prior to '77 it was primarily metal, semiconductors, and plastics. Is that correct?
A Yes.
Q What types of marks did you make in plastics?
A Primarily scribe lines, for very narrow scribe lines.
Q What was the plastic used for?
[398] A Some of these plastics were used in the printing industry for printing plates.

The Court: You have to speak up a little.

The Witness: Some of the plastics were used in making printing plates, some were decorative items, some printed circuit materials.

Q. (By Mr. Calimafde) Now, did you know the chemistry of the plastics that you laser-marked, for example, whether they were cross-linked or not cross-linked or what have you?
A No, we had no knowledge of that.
Q Did you care whether they were cross-linked or not?
A No, we did not care.
Q Do you recall any plastic that you tried to mark but you were unsuccessful in marking with a laser?
A No.
Q Any plastic which you could not mark?
A I have never run across a plastic that I could not mark.

A I have never run across a plastic that I could not mark.

Q Now, in marking these various materials were you concerned about producing a ridge around the depression?

A Yes.

Q And did some materials produce ridges around the depression?

A Yes.

Q And did some materials mark without producing ridges?

A Yes.

[399] Q. Now, which materials did you mark which did not produce ridges?

A Plastics. Some semiconductors.

Q Now, could you produce a ridge in plastic by adjusting the laser or the laser optics?

A Yes, we could create a ridge when there was none in the previous test; from one test to another we could create it.

Q Now, when you—when you laser-marked—

Mr. Pretty: Your Honor, maybe—it's just for clarification, but were you referring to still prior to 1977? I didn't understand the question.

Mr. Calimafde: Thank you. I am referring to prior to the period prior to 1977.

Q Are you still?

A Yes.

Q Now, could you avoid producing a ridge on those products which had the tendency to produce ridges by adjusting the laser or laser optics?

A Yes.

Q In marking, in laser marking plastics, did you find—was it your experience that plastics tended to produce a ridge or tended not to produce a ridge?
A Generally tended not to produce a ridge. (Tr. 397-399).

[401] * * *

Q What was your education, the highest level of education?

The Court: At that time. At that time before 1977.

The Witness: It was primarily just a high school diploma and then many courses in my field, but no degree to go with the courses. (Tr. 401).

* * *

Q Now, in 1977 you had a number of years of experience in laser applications, did you not, sir?
A Yes.
Q And at these meetings and when you met these other laser [402] engineers how did these years of experience in laser application work compared with yours?
A Many were less than mine. I had started early in this field of lasers without the education and I acquired fairly considerable length of time in the laboratory working on applications, and we drew from each other, but it seemed that I had more experience than many. (Tr. 401-402).

[424] CROSS EXAMINATION

By Mr. Pretty:

* * *

Q Am I correct that you didn't feel that you had reached a degree of expertise that you could feel very comfortable with the effects of lasers on polymers until 1978?

A That's a continuing growth of knowledge. To some degree you're comfortable with it until you learn more as I continued to work in the field.

The Court: I think the question addresses itself to a point in time in which you became comfortable with your background and knowledge in this particular field. And was that point in time 1978 or before that or after that?

The Witness: As respecting marking of plastics?

The Court: Polymers.

The Witness: I was comfortable in 1978 with that.

The Court: Is that when you became comfortable?

The Witness: You could say that's true.

The Court: All right.

Q (By Mr. Pretty) Now, isn't it true that in 1976 there were not a lot of people around the country in laser application work?

A That's true.

Q In 1976 you didn't even know even one person in laser application work who was involved in designing contact lenses, did you?

[425] A No, I did not.

Q And the idea of marking a soft contact lens by applying a laser beam to it didn't occur to you in 1976, did it?

A I wasn't aware of contact lenses at all at that time.

Q In fact, you didn't even participate in any work dealing with laser and contact lenses until 1979, did you?

A That's correct.

Q Now, Mr. Miller, have you ever had a speck of dirt get in your eye that was really uncomfortable when you blinked?

A Yes.

Q And you've had that in and you got that awful feeling there and would you say that that's a lot more sensitive than what you can feel with your finger?

A I can't say. I just know it's irritating.

Q Well, you are pretty good with feeling things with your finger, aren't you, Mr. Miller; you can feel something or you could feel a ridge, for example, on a polymer that you scribed with a laser that was as little as two tenths of a thousandths of an inch with your finger. Isn't that true?

A I believe that's approximately right.

Q That's what you said in your deposition, wasn't it?

A I don't remember the exact number but something in that order.

Q Now, have you studied the Caddell Patent that's involved in this patent lawsuit; it's plaintiff's exhibit 28 which is [426] in the blue book which you have in front of you.

A Twenty-eight?

Q Yes. Do you have it in front of you?

A Yes, I have.

Q Would you turn to column 6—the patent has numbered columns on it.

Now, you have seen this patent before, haven't you?

A Yes.

Q Now, if you look in column 6 on table 1 it has a material there that's referred to as lucite and in the column D it shows a dimension which apparently relates back to figure 6 where there is a dimension D which shows a ridge. Do you see that little D?

A Under lucite where it says two thousandths?
Q Yes. That is more than ten times what you can feel with your finger as a ridge, isn't it?
A Yes.
Q That would be pretty uncomfortable stuck in your eye blinking all day on a contact lens, wouldn't it?

Mr. Calimafde: Your Honor, I don't see the relevancy of the examination at all, examining him on what is comfortable to his eye.

The Court: I think he's getting as to whether or not—I think he is testing the weight that I should give to his testimony regarding the presence or nonpresence of [427] ridges on the plastics to which he applied the beam of—from the laser, I believe.

Mr. Pretty: That's right.

The Court: All right, I will allow it.

The Witness: Excuse me again, the question.

Q (By Mr. Pretty) Well, if you had a contact lens in your eye which had a ridge on it which was ten times greater than the ridge that you can feel with your finger, that would be pretty uncomfortable by blinking over it all day in an eight-hour day, wouldn't it?

Mr. Calimafde: Your Honor—

The Witness: Yes.

Mr. Calimafde: —Objection.

The Court: I will allow him to answer the question. I think I could take judicial notice of that fact.

Mr. Calimafde: It's irrelevant, I agree.

The Court: Not all matters over which the court can take judicial notice are irrelevant.

Mr. Calimafde: No.

Q. (By Mr. Pretty) Now, Mr. Miller, am I correct that up to 1976 the experience you had actually had in scribing on plastics—I'm concentrating on plastics now—had been primarily—well, that was the work you did at that time when you were self-employed. Is that correct?

A Yes, right.

[428] Q And I asked you about that in your deposition, you recall, and as I understand it you told me that although you had applied lasers to various polymers up to 1976 which were clear and translucent and opaque, in a way that would try to minimize ridging, you still couldn't eliminate ridging. You could always feel it when you ran your finger over it. Isn't that correct?

A Invariably. It varied with the material.

Mr. Calimafde: Objection.

The Witness: It is generally correct, but it does vary with the material.

Q (By Mr. Pretty) Let me read you what happened in your deposition.

Well, let me find it. On page 72 they had elsewhere as well—page 73, I should say.

Mr. Calimafde: What line is that?

Mr. Pretty: Starting at line 14.

Q I'm going to ask you some questions. I guess mainly up to your experience up through the end of 1976. I'm not too much concerned with your experience after that. If I can summarize where I think we've got up to so far. You had experience in applying lasers to various types of polymers up to the end of 1976. Clear, translucent and opaque. And that you tried to minimize ridging but you could still feel it by running your finger over it.

[429] Is that correct, and you answered yes, and it depends on the materials, of course; but in general in the ones that I mostly worked with, it was minimized. I can't say eliminated or not eliminated, just minimized.

And there is another portion, if you'll just bear with me a moment. Excuse me.

I can't find it at the moment. I will go on.

Now, that was a correct statement on your deposition, wasn't it?

A Yes. (Tr. 424-429).

[545] TESTIMONY OF DONALD BRUCKER

DIRECT EXAMINATION

* * *

Q (By Mr. Calimafde) When did Continuous Curve begin to experiment with laser marking of soft contact lenses?
A I believe it was in '79. '79, '80, somewhere in that area.
Q Were you with the company at that time?
A Yes.